

OHNISHI**Application No. 09/809,095****Response to Office Action dated April 6, 2005****Remarks**

Reconsideration and allowance of the subject patent application are respectfully requested.

Claims 1, 3, 4 and 12 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. (U.S. Patent No. 6,097,389) in view of Savitzky et al. (U.S. Patent No. 6,571,271). Morris et al. discloses creating photo albums from various digital images. With reference to Figure 12B, the office action apparently contends that the images on the album page 807 are the claimed "reduced-size" images and that the thumbnails in the separate thumbnail region 809 are the claimed "file icons." In one described implementation, the assigned order of pictures in an album may be changed by dragging and dropping one of the "thumbnails" from a current position in the thumbnail region to another position in the thumbnail region. The picture album will then automatically and dynamically reposition the pictures in the album pages based on the changes made in the thumbnail region. See, e.g., col. 13, lines 36-61.

The office action acknowledges that Morris et al. is at least deficient with respect to disclosing the displaying of an icon concurrently with a reduced image wherein the display position of the file icon relative to the display position of the reduced-size image is predetermined to be the same for each reduced-size image/file icon pair. The office action references Savitzky et al. to remedy this acknowledged deficiency of Morris et al.

Savitzky et al. discloses an HTML page in which images 306 each have an associated caption 308. The office action contends that the captions of Savitzky et al. can be viewed as constituting "icons" because "a user can click on one of the captions to perform an action." 4/6/2005 Office Action, page 3. See col. 3, lines 17-20 of Savitzky et al. ("Captions 308 are shown as HTML links, so that a user can click on one of the captions 308 to perform an action such as showing a larger view of the image or allowing a caption to be edited.").

Applicant traverses, among other things, the contention that Savitzky et al. cures the deficiencies of Morris et al. with respect to claim 1. Specifically, claim 1 calls for the dragging-and-dropping or moving of the file icon to, for example, select a function or move an associated reduced-size image. Savitzky et al. simply describes that clicking on a caption can show a larger view of the image or allow the caption to be edited. There is nothing in Savitzky et al. that would have suggested that Morris et al. be modified to provide icons that are positioned relative

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to corresponding reduced-size images and that are dragged as described in claim 1 to select functions to be applied to a data file or to change a display position of one of the reduced-size images. Indeed, Savitzky et al. mentions using a "form" to rotate, delete or move images. See Savitzky et al., col. 3, lines 7-9.

Moreover, there is no apparent reason for modifying Morris et al. as proposed and there is no evidence to establish that arranging thumbnails 809 and images 807 as allegedly suggested by Savitzky et al. would "simplify presentation and selection of images over the web" as stated in the office action. Indeed, because images 809 and thumbnails 807 are different views of the same group of images, the proposed modification would result in the concurrent display of two versions of each image. Applicant submits that this would complicate, rather than simplify, presentation and selection of images. At best, Savitzky et al., might suggest providing captions for the reduced size images of Morris et al. However, for the reasons stated, there is nothing in Savitzky et al. that would have suggested that Morris et al. be modified as proposed.

Consequently, claim 1 and its dependent claims 3, 4 and 12 are believed to be allowable over the proposed combination of Morris et al. and Savitzky et al.

Claim 2 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. in view of Savitzky et al. in view of Johnston, Jr. et al. (U.S. Patent No. 5,598,524) and Belfiore et al. (U.S. Patent No. 5,611,060). For the reasons set forth below, Applicant traverses this rejection.

Claim 2 is directed to an aspect of dragging of the file icon. Namely, if the drag operation is performed at a speed equal to or greater than a predetermined speed, the reduced-size image is fixed at a current position while a drag operation is performed. If the drag operation is below the predetermined speed, a frame having the size of the reduced-size image is displayed. The office action acknowledges that Morris et al. is deficient in this regard, but contends that Johnston, Jr. et al. and Belfiore et al. remedy this deficiency. However, neither of these references teach or suggest how to treat a reduced-size image when its corresponding file icon is dragged at particular speeds.

Johnston, Jr. et al. describes that a shape such as a rectangle may be used to represent a dragged object. However, Johnston, Jr. et al. does not relate this operation to the speed of dragging in any way, nor does Johnston, Jr. disclose how the appearance of a reduced-size image

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should vary when a corresponding file icon is dragged. Belfiore et al. describes that an auto-scrolling operation may be made to depend on the speed of a mouse indicator during a drag-and-drop operation. Here again, Belfiore et al. does not disclose or even suggest how the appearance of one object should change based on the dragging speed of some other object such as a file icon. There is no possibility that one of ordinary skill in the art would have arrived at the subject matter of claim 2 based on Johnston, Jr. and Belfiore et al. absent impermissible hindsight.

For at least these reasons, the proposed combination of Morris et al., Savitzky et al., Johnston, Jr. et al. and Belfiore et al. would not have rendered claim 2 obvious.

Claims 5-7 and 11 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. in view of Savitzky et al. further in view of Hirose (U.S. Patent No. 5,745,112). For the reasons set forth below, Applicant traverses this rejection.

Claims 5-7 and 11 are directed to the concept of an icon return space. The illustrative example embodiments of the subject patent application describe that when a file icon is dropped in an icon return space, the file icon is moved back to its original display position without moving the associated reduced-size image. See, e.g., page 9, line 25 to page 10, line 5. The office alleges that the dotted line in Figure 7 of Hirose et al. illustrate an icon return space. However, even assuming for the sake of argument that region 311 is argued to correspond to an icon return space, there is no disclosure of displaying such a space based on the distance of the file icon from a corresponding reduced-size image, nor does the office action address this feature of the claims. For at least these reasons, the proposed combination of Morris et al., Savitzky et al. and Hirose would not have rendered the subject matter of claims 5-7 and 11 obvious. Should any rejection of these claims be maintained, Applicant respectfully requests that some evidence be provided in connection with displaying the icon return space based on the distance of the file icon from a corresponding reduced-size image as claimed.

Claim 8 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. in view of Savitzky et al. in view of Hirose, and further in view of Aparacio, IV et al. (U.S. Patent No. 5,727,174). For the reasons set forth below, Applicant traverses this rejection.

Claim 8 specifies that the icon return space is larger in size than the file icon. This is shown and described in the illustrative example embodiments with reference to Figure 3(b) and

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its related description beginning at page 10, line 20. The office action alleges that the frame around the mini-desk 49 in Figure 6 of Aparicio, IV et al. is an icon return area that is larger in size than the file icon (human figure 47) to be returned thereto.

Claim 8 depends from claim 5 and Aparicio, IV et al. does not cure the deficiency of Hirose with respect to, among other things, displaying an icon return space based on the distance of a file icon from a corresponding reduced-size image. In addition, human assistant 47 is not a file icon associated with a reduced-size image of a data file. For at least these reasons, the proposed combination of Morris et al., Savitzky et al., Hirose and Aparicio, IV et al. would not have rendered claim 8 obvious.

Claims 9, 13, 14 and 20-25 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. in view of Savitzky et al. further in view of and Johnston et al. Claims 13, 24 and 25 include subject matter along the same lines as claim 1 (from which claim 9 depends) and thus Morris et al. is deficient with respect to these claims for the reasons previously stated in connection with claim 1. Savitzky et al. does not cure these deficiencies as further explained in connection with claim 1. The portion of Johnston, Jr. et al. referenced in the office action with respect to claim 13 relates to dragging an icon for a document to an icon for a printer. However, Johnston, Jr. et al. provides no disclosure or suggestion whatsoever with regard to reduced-image/file icon pairs and thus the addition of Johnston, Jr. et al. to the proposed Morris et al.-Savitzky et al. combination would not have resulted in the subject matter of claims 9, 13, 24 and 25.

Claim 14 and 20-23 depend from claim 13 and are believed to be allowable because of this dependency and because of the other patentable features recited therein.

Claim 15 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris et al.-Savitzky et al.-Johnston et al. combination, in further view of Fleming (U.S. Patent No. 5,392,389). At least because Fleming does not remedy the deficiencies of the proposed Morris et al.-Savitzky et al.-Johnston et al. combination with respect to claim 13 (from which claim 15 depends), Applicant respectfully submits that claim 15 is not rendered obvious as alleged in the office action.

Claims 16 and 17 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris et al.-Savitzky et al.-Johnston et al. combination, in further

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view of Hirose. At least because Hirose does not remedy the deficiencies of the proposed Morris et al.-Savitzky et al.-Johnston et al. combination with respect to claim 13 (from which claims 16 and 17 each depends) and because of the deficiencies of Hirose noted above, Applicant respectfully submits that claims 16 and 17 are not rendered obvious as alleged in the office action.

Claim 18 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris et al.-Savitzky et al.-Johnston et al.-Hirose combination, in further view of Aparicio, IV et al. At least because Aparicio, IV et al. does not remedy the deficiencies of the proposed Morris et al.-Savitzky et al.-Johnston et al.-Hirose combination with respect to claim 16 (from which claim 18 depends) and because of the deficiencies of Aparicio, IV et al. noted above, Applicant respectfully submits that claim 18 is not rendered obvious as alleged in the office action.

Claim 19 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris et al.-Savitzky et al.-Johnston et al. combination, in further view of Belfiore et al. At least because Belfiore et al. does not remedy the deficiencies of the proposed Morris et al.-Savitzky et al.-Johnston et al.-Hirose combination with respect to claim 13 (from which claim 19 depends) and because of the deficiencies of Belfiore et al. noted above, Applicant respectfully submits that claim 19 is not rendered obvious as alleged in the office action.

New claims 26-30 have been added. The subject matter of these new claims is fully supported by the original disclosure and no new matter is added.

Claim 26 is directed to a method for processing data files involving displaying file icons corresponding to respective data files in a first area on a display screen, wherein images of contents of the data files are not perceivable from the file icons; moving the file icons for one or more of the data files to a second area of the display screen; for the file icons moved to the second area of the display screen, generating thumbnail images of contents of the corresponding data files; displaying the thumbnail images in the second area of the display screen at positions spaced apart from the file icons; and moving one or more file icons in the second area of the display screen to a function-invoking area of the display screen to invoke functions on the data files corresponding to the moved file icons. None of the applied document discloses or suggests

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file icons and thumbnail images as claimed. Consequently, claim 26 and its dependent claims 27-30 are believed to be allowable.

For at least the reasons set forth above, the pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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